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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,612	06/18/1999	BERNARD BENDINER	9850/3	7868

757 7590 03/22/2002

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, IL 60610

EXAMINER

CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 03/22/2002

26

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-26

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/336,612	BENDINER, BERNARD	
	Examiner	Art Unit	
	LaToya I. Cross	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on January 25, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/336,612 is acceptable and a CPA has been established. An action on the CPA follows. Claims 1 and 2 are pending in the instant application.

### *Withdrawal of Rejections from Previous Office Action*

- The rejection of claim 2 under 35 USC 112, second paragraph is withdrawn in view of Applicants' amendment to the claim to put it into independent form.
- The rejection of claims 1 and 2 under 35 USC 102(e) over Nakajima et al is withdrawn in view of Applicants' amendment to the claims to recite "consisting of", which excludes the presence of any additional components.
- The rejection of claims 1 and 2 under 35 USC 103(a) over Nomura et al is withdrawn in view of Applicants' amendment to the claims to recite "consisting of", which excludes the presence of any additional components.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,374,174 to Stricklin et al (hereinafter Stricklin et al '174).

Stricklin et al '174 disclose a composition for inhibiting the corrosion of metals. The compositions comprise potassium sorbate as the main and only ingredient. The potassium sorbate is present in solution in an amount of about 10 – 70% by weight. According to the table shown at col. 3, the kraft product treated with potassium sorbate better inhibited the occurrence of corrosion than did the untreated control kraft product.

Stricklin et al '174 differ from the instantly claimed invention in that there is no specific disclosure of the pH of the solution used.

However, it would be reasonable to expect, given the superior results against corrosion of the kraft paper treated with potassium sorbate, that the pH of the solution would have to be in a range such that these results would occur. It is known in the art of metal corrosion that low pH is one of the principal causes of corrosion. One of ordinary skill in the art would then realize that a high pH would be necessary to prevent unwanted corrosion from occurring.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Stricklin et al '174.

***Response to Arguments***

The rejection over the Stricklin et al reference was given in a previous Office Action dated June 20, 2001. The Examiner withdrew the rejection because Applicant amended claim 1 to recite the presence of potassium sorbate in an amount of 0.3% by weight. Applicants have now amended the claim to recite 0.3% by weight, or higher of potassium sorbate. Thus, the Stricklin reference reads on the claim and the rejection is being reinstated.

***Allowable Subject Matter***

5. Claim 2 is allowed. The prior art of record do not teach or suggest a composition consisting of only potassium sorbate and water, wherein the potassium sorbate is present in a specific amount and wherein the solution has a specific pH. The prior art of record also fails to teach or suggest such a composition having lower oxygen content and lower electrical conductivity to allow a metal surface to remain corrosion-free.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 703-305-7360. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

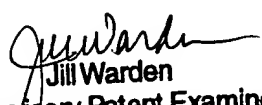
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

LIC

March 19, 2002

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700